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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/658,976	09/10/2003	Alfred Thomas	47079-0227	3979

30223 7590 04/21/2006

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EXAMINER	
SPRIGG, SEAN M	

ART UNIT	PAPER NUMBER
3712	

DATE MAILED: 04/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/658,976	THOMAS, ALFRED	
	Examiner	Art Unit	
	Sean Sprigg	3712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-25* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-25* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *9/10/03, 01/18/05*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 21 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: selecting ones of the cards to be replaced. The claim currently includes a step of drawing replacement cards for selected cards, but there is no step for selecting cards to be replaced. It is therefore unclear as to which cards are considered selected and how they become selected, whether it be the player or the game performing the selection step. For the purposes of this examination, claim 21 will be interpreted to have a selection step.

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-10 and 21-25 are rejected under 35 U.S.C. 101 because the claimed invention lacks patentable utility. Specifically, the claimed invention must produce a "useful, concrete and tangible result" to have a practical application. See MPEP 2106 II A. The invention as currently claimed is drawn to a method that produces no clear tangible result. The methods of conducting a video draw poker game do not provide any tangible result such as displaying a win or lose occurrence on a display screen,

proving an award for a win, or the like. As the methods are currently claimed, the individual steps may be involve tangible elements, such as highlighting, flashing, or labeling cards in a distinguishing step, but the game method's result is intangible as determining a poker hand ranking could be performed abstractly and does not appear to produce any tangible, real-world outcome.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 4-5, 8-11, 14-15, 18-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Wolf'483 (US Pub No 2004/0063483).

Claims 1, 21: Wolf'483 teaches a method of conducting a video draw poker game, the game defining a plurality of award-winning rankings and awards associated with the rankings. Wolf'483 teaches receiving a wager (par. 32), dealing a plurality of cards into a hand (par. 32), distinguishing winning cards in the hand that yield the winning ranking from other non-winning cards (pars. 33, 39, also see lead line 33), selecting none or more of the cards to be replaced (par. 33), replacing each of the selected cards with a respective replacement card (par. 33), and determining a poker hand ranking for the hand (par. 33).

Wolf'483 explicitly teaches the distinguishing step occurring if the dealt hand includes one of the award winning rankings by teaching a variety of different auto-hold strategies, including a "conservative" strategy that teaches auto-holding cards which are part of an existing winning combination (par. 44). Additionally, Wolf'483 teaches the distinguishing step can only occur if the dealt hand includes a award-winning ranking in that the auto-hold strategies used can be defined by the operator and, therefore allows for the operator to define a auto-hold strategy that only holds cards that are part of an award-winning ranking hand (pars. 10-11 and 44-62).

Claim 11: Wolf'483 teaches an apparatus conducting the video draw poker game method having a value input device (lead lines 12, 14), a display (lead line 30), and a processor operative to perform the steps of the game method (lead line 38).

Claim 4, 14: Wolf'483 teaches distinguishing winning cards to be held with a label (lead line 33).

Claim 5, 15, 22: Wolf'483 teaches the distinguishing step occurring automatically (par. 33).

Claims 8-9, 18-19: Wolf'483 teaches the plurality of cards including at least five cards (par. 32) and the cards being dealt from a deck including 52 standard playing cards (par. 32).

Claim 10, 20: Wolf'483 teaches the player performing the selecting step with a player input (par. 33).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 2-3, 12-13, 24-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolf'483 in view of Baerlocher'383 (US Pub No 2003/0153383).

Claims 2-3, 12-13, 24-25: Wolf'483 teaches all the features of the presently claimed invention except for the distinguishing step of the game method occurring in response to a player's activation of an "easy hold key", which is merely a button giving the player the option of to activate a game feature of distinguishing certain cards in certain instances.

Baerlocher'383 teaches a game method wherein the player is provided with a button that can be activated by the player (par. 69). If the button is activated a game feature distinguishing certain desirable elements of the game are highlighted (par. 69). Baerlocher'383 teaches this feature to increase the entertainment value of the machine by providing an optional feature that may appeal to a certain players while not forcing all players to use the feature.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Wolf'483 with a button the player can use to activate the distinguishing step of the method for the purposes of increasing the entertainment value of the machine by allowing some players to enjoy a

using the distinguishing step feature while not forcing all users to use the distinguishing step.

6. Claims 6-7, 16-17, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolf'483 in view of Davids'536 (USPN 5,833,536).

Claims 6-7, 16-17, 23: Wolf'483 teaches all the features of the presently claimed invention except for the distinguishing being highlighting and flashing of winning ones of cards.

Davids'536 teaches a game that distinguishes certain indicia, such as electronically represented playing cards, by highlighting and flashing them (col. 7 lines 61-67). Davids'536 teaches this type of distinguishing feature because it is a more effective technique to draw player's attention to a highlighted/flashing object in a display than it is to draw their attention to a dim/static object in a display.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Wolf'483 with a distinguishing step including highlighting and flashing of winning cards as taught in Davids'536 for the purposes of attracting more attention to distinguished cards than a dim or static display.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Meyer'487 (US Pub No 2003/0092487), Wood'762 (US Pub No

2002/0037762), Vancura'109 (US Pub No 2003/0137109), Moody'641 (US Pub No 2002/0125641).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sean Sprigg whose telephone number is (571) 272-5562. The examiner can normally be reached on Monday - Friday, 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on (571) 272-7147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SMS
4/14/2006

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TC3700